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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/831,95	4 06/25/	01 LOOZEN H	0/98414-U8

HM12/1023

EXAMINER

WILLIAM M BLACKSTONE AKZO NOBEL 1300 PICCARD DRIVE SUITE 206 ROCKVILLE MD 20850-4373

JIANG, S

ARTUNIT PAPER NUMBER

1617

DATE MAILED:

10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks** 

Office Action Summary		Application	n No.	Applicant(s)			
		09/831,95	4	LOOZEN ET AL.			
		Examiner		Art Unit			
		Shaojia A.		1617			
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply							
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).  Status							
1)	1) Responsive to communication(s) filed on						
2a) <u></u> ☐	This action is <b>FINAL</b> . 2b)⊠ T	his action is	non-final.				
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.							
Disposition of Claims							
4)⊠ C	claim(s) $1-6$ is/are pending in the application	١.					
4a) Of the above claim(s) is/are withdrawn from consideration.							
5) Claim(s) is/are allowed.							
6)⊠ Claim(s) <u>1-6</u> is/are rejected.							
7) 🗌 🤇	Claim(s) is/are objected to.						
8)□ (	Claim(s) are subject to restriction and/	or election re	equirement.				
Applicatio	n Papers						
9)☐ The specification is objected to by the Examiner.							
10)∐ Ti	ne drawing(s) filed on is/are: a)□ acce	epted or b)	objected to by the Exa	miner.			
	Applicant may not request that any objection to ti						
11)☐ The proposed drawing correction filed on is: a)☐ approved b)☐ disapproved by the Examiner.							
If approved, corrected drawings are required in reply to this Office action.							
,	ne oath or declaration is objected to by the E	xaminer.					
•	der 35 U.S.C. §§ 119 and 120						
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).							
a)⊠ All b)□ Some * c)□ None of:							
1. Certified copies of the priority documents have been received.							
2. Certified copies of the priority documents have been received in Application No							
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.							
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).							
•	a) The translation of the foreign language provisional application has been received.  15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.						
Attachment(s)							
1) Notice 2) Notice	of References Cited (PTO-892) of Draftsperson's Patent Drawing Review (PTO-948) ution Disclosure Statement(s) (PTO-1449) Paper No(s)	<u>1</u> .	· <del></del>	y (PTO-413) Paper No(s) Patent Application (PTO-152)			

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## **DETAILED ACTION**

This application is a 371 of PCT/EP99/09053 which claims priority to EPO 98203914.1.

## Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 provides for the use of a compound of formula I in claim 13, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 6 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

In order to expedite prosecution, these claims will be examined on the merits as a method of use herein.

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## Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Lobaccaro et al. (AQ, PTO-1449 submitted June 25, 2001).

Lobaccaro et al. teach compound 5b therein, within the instant claimed compounds, and its composition. See Scheme 1 compound 5b on page 2218, Table 1 on page 2219, Table 2 on page 2221, and the 4<sup>th</sup> paragraph of page 2224. Lobaccaro's teaching is also inherent in a method of the treatment of estrogen-deficiency dependent disorders. See *Ex parte Novitski*, 26 USPQ 2d 1389. Thus, Lobaccaro et al. anticipates the claimed invention.

Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Napolitano et al. (AR, PTO-1449 submitted June 25, 2001).

Napolitano et al. teach 11β-substituted estradiol derivatives as the estrogen receptor such as compound 21 therein within the instant claimed compounds and its composition. See abstract and Table 1 on page 2776. Napolitano's teaching is also inherent in a method of the treatment of estrogen-deficiency dependent disorders. See *Ex parte Novitski*, 26 USPQ 2d 1389. Thus, Napolitano et al. anticipates the claimed invention.

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Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Baran et

al. (3,755,301, PTO-892).

Baran et al. disclose 11-alkyl steroids within the instant claimed compounds. See

abstract and col.1 lines 2-21. Thus, Baran et al. anticipates the claimed invention.

In view of the rejection to the pending claim set forth above, no claims are

allowed.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-

1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone

number for the organization where this application or proceeding is assigned is (703)

308-4556.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 305-

1235.

Shaojia A. Jiang, Ph.D.

Patent Examiner, AU 1617

October 12, 2001

MINNA MOEZIE, J.U. SUPERVISORY PATENT EXAMINER

TECHNOLOGY CENTER 1600

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